

REMARKS

Claims 1, 2, 5, 6, 8-10 and 12-17 were rejected as being anticipated by Ichikawa (EP 897795). This rejection is respectfully traversed.

“Anticipation is a question of fact, and we [i.e., the Federal Circuit] uphold decisions of the Board on factual matters if there is substantial evidence in the record to support the Board’s findings.” *Rapoport v. Dement*, 254 F.3d 1053, 59 USPQ2d 1215 (Fed. Cir. 2001). “Whether a claim limitation is inherent in a prior art reference is a factual issue on which evidence may be introduced.” *Id.*

On page 3, first paragraph of the Action the Examiner has alleged the following:

With respect to the present claim limitation requiring that the differences between the reflected absorption of the non-printing area which holds the ink-repelling layer and the reflected absorption of said printing area observed after dyeing of the printing plate at the absorption maximum wavelength of the dye in said dyeing solution is not less than 0.3 and not more than 2.0, the limitation requiring that the maximum dye absorption be within a certain range, and to the limitation requiring that that ratio A/B be a certain value, it is the position of the examiner that since the material of the reference comprises the same dyes having wavelengths within the preferred range of the present application, is dyed employing visible dyes taught by the present specification as being suitable for use in the invention of the reference, and appears to be made using the same method steps, that when made, the printing plate of the reference would inherently possess the presently claimed properties, especially given that the reference teaches that the image area/non-image area boundary is able to be observed visually after dyeing.

These statements of the Examiner do *not* provide *substantial evidence* to support inherency, which is a factual issue. On the contrary, the Applicants have provided evidence in Mr. Nagase’s Declaration of July 23, 2003, filed with the Amendment to the Action of March 10, 2003 that the closest prior art examples do *not* inherently disclose some of the claimed features of the printing plate of this invention.

Yet in paragraph 3 of the Action, the Examiner stated that Mr. Nagase’s Declaration was not persuasive. The Examiner emphasized that the reproduced Examples 7 and 24 in Mr.

Nagase's Declaration did not use Crystal Violet and Victoria Pure Blue, but instead used C. I. Basic Blue, for dyeing the plate during plate processing (see page 5, line 10 of Mr. Nagase's Declaration).

The Applicants would like to point out that the values of the ratio A/B is measured *before* dyeing (see page 9, lines 16-24 of the specification). Therefore, even if Crystal Violet or Victoria Pure Blue was used in the reproduced Examples 7 and 24 of Mr. Nagase's Declaration, the values of the ratio A/B would still be substantially the same as those shown in Mr. Nagase's Declaration because the measurements of the values of the ratio A/B was done *before* dyeing. Persons of ordinary skill in this art would recognize that the ratio A/B is not impacted by the type of dye present in the dye liquid used in a *subsequent* dyeing step.

"To prove inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, cannot be established by probabilities or possibilities." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). The Examiner is simply hypothecating and taking a retrospective view of inherency in arguing that "the printing plate of the reference would inherently possess the presently claimed properties" See page 3, lines 10 and 11, of the Action. "[A] retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination." *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 814 (1989).

Please review Mr. Nagase's Declaration, in which Mr. Nagase reproduced Examples 7 and 24 of Ichikawa as disclosed in Ichikawa except for the following: (1) Mr. Nagase used an 8 micrometer "Torayfan" polypropylene film instead of an 8 micrometer "Lumminor" polyester film in the laminate in Example 7. (In Example 24 of Ichikawa "Torayfan" was used and reproduced Example 24 also used the same.) (2) In reproduced Examples 7 and 24, plate-making machine FX400 was used for laser beam irradiation, which is the same as that used in the

present invention but not the same as that used in Ichikawa. The reason Mr. Nagase used FX400 is because the plate-making machine described in the Examples of Ichikawa is not available now. Mr. Nagase believes, which persons of ordinary skill would recognize, that the difference between FX400 and the plate-making machine of Ichikawa would not impact the claimed ratio of A/B. Other than these changes, which would not impact the claimed ratio of A/B, Examples 7 and 24 of Ichikawa and reproduced Examples 7 and 24 of Mr. Nagase's Declaration are substantially identical. In particular, Mr. Nagase used the *same* "C. I. Basic Blue 1 dyestuff" in the dye liquid as that used in Examples 7 and 24 of Ichikawa.

The Examiner's position is that Mr. Nagase did not use Crystal Violet and Victoria Pure Blue for dyeing the plates of Examples 7 and 24 in Mr. Nagase's Declaration to prove that Examples 7 and 24 of Ichikawa do *not* inherently possess the claimed A/B ratio. This position is not only *irrelevant* as explained above but also *totally incorrect* under the law. To prove that something in the prior art does not inherently possess a certain claimed property, a person of ordinary skill in the art must test a closest embodiment disclosed in the prior art, *not* a hypothetical embodiment resulting from a retrospective view of inherency as applied by the Examiner.

In order for persons of ordinary skill to determine whether the Examiner's alleged position on inherency is *factually* correct or not, the Examiner must at least first define a "thing described in the reference," such as an example or an embodiment of the reference, that can be tested for the presence or absence of the alleged inherent characteristic such that evidence may be introduced to rebut inherency. The Examiner has failed to state a *thing* described in the reference that would necessarily result in the alleged inherent characteristics.

When the undersigned called the Examiner on June 2, 2003, prior to the response to the first Action to check what the Examiner considers to be the closest prior art example or embodiment that the Applicants should test to prove or disprove inherency, the Examiner said that the Applicants should make this determination, which the Applicants did and submitted a Mr. Nagase's Declaration filed with the Amendment to the Action of March 10, 2003.

Yet, the Examiner found this Declaration unpersuasive. Also, the Examiner failed to define a “thing described in the reference” that should be tested for evidence of inherency or lack thereof. Instead, the Examiner only provided general remarks that the claimed characteristics may occur or be present in the reference. The fact that a certain result or characteristic *may* occur or be present in the prior art is *not* sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). In short, the Examiner has failed to establish a *prima facie* case of anticipation based on inherency.

The Applicants respectfully submit that the Examiner should clearly state on the record “the *thing* described in the reference,” as required by *In re Robertson*, cited above, in which the alleged inherent characteristics are necessarily present or withdraw the anticipation rejection.

In addition, on page 4, first paragraph of the Action, the Examiner has stated:

Applicant has argued that the examiner’s assertion that the material of Ichikawa et al inherently possesses the presently claimed properties, specifically those requiring that the difference between the reflected absorption of the non-printing area which holds the ink-repelling layer and the reflected absorption of said printing area observed after dyeing of the printing plate at the absorption maximum wavelength of the dye in said dyeing solution is not less than 0.3 and not more than 2.0, the limitation requiring that the maximum dye absorption be within a certain range, and the limitation requiring that that ratio A/B be a certain value.

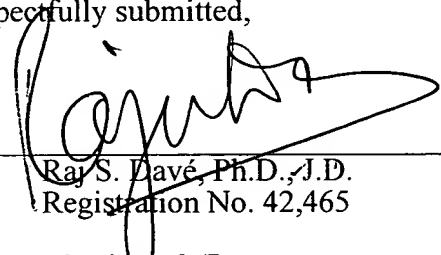
For the record, the Applicants respectfully submit that this statement of the Examiner is incorrect. The Applicants have only argued that the closest prior art does not meet the limitation requiring that the maximum dye absorption be within a certain range, and the limitation requiring that the ratio A/B be a certain value, but not the rest of the assertions made by the Examiner.

In the event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 360842007600. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: December 2, 2003

Respectfully submitted,

By:



Ray S. Davé, Ph.D., J.D.
Registration No. 42,465

Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 300
McLean, Virginia 22102
Telephone: (703) 760-7755
Facsimile: (703) 760-7777